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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,256	12/22/2006	Hugues De Feraudy	2901653.13	2220

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Baker Donelson Bearman Caldwell & Berkowitz PC  
Att: Docketing Sixth Floor  
555 11th Street N.W.  
Washington, DC 20004

EXAMINER
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TISCHLER, FRANCES

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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05/20/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/576,256

**Applicant(s)**

FERAUDY ET AL.

**Examiner**

FRANCES TISCHLER

**Art Unit**

1796

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1 – 32 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1- 7 and 10 - 34 of copending Application No. 10/582545. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Both applications claim a method for selective separation by density of a mixture of waste synthetic organic materials to be reused having a density of at least 1. The density separation is done in a separator in an aqueous suspension with powder particles used for creation of density levels. The instant application broadly claims

stabilization of the suspension in independent claim 1. Later dependent claims define this stabilization with compounds such as phosphates, polymers of acrylic acids, etc. 10/582545 claims the same compounds for stabilization and claims further dynamic stabilization through circulation in the separator, the circulating flow rate values (claims 1, 8, and 9) of which are absent in the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Claim Rejections - 35 USC § 112***

Claims 8 – 20 and 32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant claims a water-soluble acrylic copolymer. However, in some embodiments of the claim, such as when  $n = 0$ , the polymer is no longer acrylic.

***Claim Rejections - 35 USC § 103***

Claims 1 – 5, 20 and 22 – 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feraudy (US 6,460,788) in view of Allen (WO 2004/009200).

Regarding claims 1, 2 and 31: **Feraudy** discloses (abstract, column 3, lines 6 – 34, column 4, lines 14 - 19) a method of separating a mixture of polymers, such as PE, PP, PS, ABS, PPMA, PVC, etc., derived from waste using a density separation technique. The density separation is done in a liquid medium (column 3, lines 23 – 25). The density of the polymers range from below 1 to 1.25 (column 5, lines 65 - end, column 6, lines 1 - 35). The density separation can be done in a single separator or in several separators connected in parallel or in series (column 3, lines 6 – 35, column 6, lines 31—35, column 8, lines 41 - 45). Feraudy preferably uses floatation hydraulic separators comprising water, wetting agents and inorganic compounds (column 6, lines 36 – 46). Other separators that may be used include cyclones.

Feraudy is silent on the size of the inorganic compounds/powder particles and precision level of the density reading.

The inorganic compound used to increase the density of the water comprises clays, bentonite or soluble compounds and salts, calcium carbonate, talc, silica, alumina (column 6, lines 36 – 46, column 8, lines 18 - 20), reading on applicant's claims 3 and 4.

Feraudy discloses the use of sodium hydroxide and calcium hydroxide (column 8, lines 12 – 15), reading on Applicant's claim 20.

Feraudy is silent on the conductivity of the aqueous phase claimed in claim 22. However, applicant admits ([0105]) that the water to be used in making the aqueous suspension can be spring water, drinking water, treated or untreated industrial water, sea water, etc. Therefore, the conductivity of Feraudy's aqueous suspension is

inherently the same as applicant's claimed suspension, since the water can come from any source and Faraday is not specific as to what water to use, and both applicant and the prior art add inorganic compounds and stabilizing agents to make the same suspension for the same purpose of separating polymers according to densities.

The hydraulic separators disclosed by Feraudy can be static separators, dynamic separators, electrostatic, or those with a pump and a cyclone to produce a circulating sorting flow (column 12, lines 3 – 11), reading on applicant's claims 23, 25 and 30. Feraudy also discloses that the circulation rates vary depending on how the procedure is done, such as once or batchwise, and should be optimized accordingly (column 12, lines 12 - 17).

Feraudy discloses doing a first phase of density separation where the density is decreased from 1.25 to 1, followed by a second phase of density separation, where the density is increased from 1.25 – 1 (column 3, lines 6 – 35), reading on applicant's claims 24 and 30. The various stages of separation in parallel or in series (column 3, lines 6 – 34, column 6, lines 31 – 35), read on claims 26 and 30.

Feraudy discloses that the density separation can be done on a smooth or stepwise function (column 3, lines 12 – 16), in one separator or in more than one separator (column 6, lines 64 – 67). The density is decreased or increased by automatic addition of a precise amount of water (column 6, lines 57 – 61), or by an automatic addition of a precise amount of clay (column 9, lines 5 – 15), which reads on applicant's claim to continuously control the aqueous suspension in claim 27. Feraudy is silent on the mechanics of how the automatic addition of precise amounts of water is performed,

as claimed by applicant in claims 28 and 29 where solenoid valves connected to tanks allows more or less water to be added depending on density readings. It can be assumed that since Feraudy's addition of water or clay is automatic and precise, it had to be done electronically (because it is disclosed to be an automatic process), with automatic reading of density, and the water or clay needed to come from a reservoir (because the process is automatic, the addition of water is not done manually).

Feraudy discloses density separation of the polymers where the densities measure 1.25, 1.18, 1.15, 1.10, 1.05 and 1 (column 6, lines 49 – 56, column 7, lines 1 – 15, column 9, lines 16 - 30), corresponding to a precision level of  $\pm 0.005$ . Applicant claims a precision level of  $\pm 0.0005$ . Neither applicant nor Feraudy disclose the brand of the apparatus used for density readings. The precision of the reading is dependent on the apparatus used. Since Feraudy is separating out the same polymers and by the substantially identical method as claimed by applicant, the densities of both inventions are inherently equivalent. Alternatively, it would have been obvious to one of ordinary skill in the art to have varied the experimental conditions, such as type, amount and size of powder, precision of the density reading device, flow rate, amount of stabilization agent, etc., through routine optimization to have arrived at the desired precision.

Feraudy discloses the use powder particles in water to aid in the density separation of polymers but is silent on the size of these particles as claimed in claims 1, 2 and 5.

**Allen** discloses (page 1, lines 11 – 15 and lines 26 – end, page 10, lines 16 - 22) a method of separating mixtures of used polymers using a density separation technique. The polymers are added to slurry consisting of water and magnetite, titanium dioxide, sand, ferrosilicate or other materials, reading on applicant's metallic powders of claim 4. Sand reads on applicant's silica of claim 3. The particle size ranges from 5 to 30 microns (page 2, lines 5 – 23, page 4, lines 13 - 22), reading on applicant's particle size of no more than 30, 20 and 5 microns of claims 1, 2 and 5.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have substituted Feraudy's powder particles, such as clays, bentonite, salts, silica, etc. with Allen's powder particles, such as magnetite metallic powder, sand, etc. for the same results since both are using the same particles such as sand/silica for the same purpose of making a slurry with it in combination with water and the polymers to be separated by density.

**Claims 6 - 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feraudy (US 6,460,788) in view of Allen (WO 2004/009200) and further in view of Boutin et al (US 4,504,643).**

The disclosure of Feraudy and Allen are discussed above and are incorporated herein by reference.



Feraudy discloses the use of wetting agents, such as Coatex's SP 30 S, to keep the clay in suspension (column 6, lines 46 – 48), reading on applicant's use of a stabilizing agent, but is silent on the specific agents claimed by applicant.

**Boutin** discloses (abstract, column 1, lines 1 – end, column 2, lines 1 – 30 and 63 – end, column 3, lines 1 – 30) the use of water soluble polymers used in aqueous environments as stabilizers/scale inhibitors to keep certain compounds, such as calcium carbonate in suspension and so these compounds don't separate out to the bottom of the vessel. The aqueous environment can be underground water, watercourse water, sea water, etc. The stabilizer polymer includes for example, alkali metal polyphosphates, homopolymers or copolymers of acrylic or methacrylic acid and corresponding alkali metal salts thereof, homopolymers or copolymers of maleic acid, polymers of ethylenic monoacids, copolymers of an alkali metal methallylsulfonate, such as sodium methallylsulfonate, with a monoethylenically unsaturated acid such as acrylic or methacrylic acid. The above stabilizers read on several species claimed by applicant in claims 6 - 19. The metal ions read on applicant's claim 20. The molecular weight of a water soluble copolymer of acrylic acid and vinyl sulfonate ranges from 1,000 to 25,000, which are within applicant's claimed range of 5,000 – 100,000 of claim 19.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have substituted Feraudy's stabilizing agent for any one of Boutin's stabilizing agents since the purpose of either agent is the same, which is to stabilize the

aqueous suspension that contains particles, such as calcium carbonate, salts, clays, etc., so that these particles don't separate out from the suspension.

Applicant claims 0.02% - 5% of stabilizing agent with respect to the powder particles in claim 21. Feraudy and Boutin are silent on this ratio. However, Boutin discloses (column 3, lines 25 – 30) doses of 0.2 to 50 mg/liter (i.e., 0.02 – 5%) of stabilizing agent per liter of water. Since Feraudy's slurry contains a large amount of powder particles so that it can be considered to be slurry, it necessarily contains a much larger amount of powder particles than stabilizing agent. The exact amounts of each can be optimized for the desired results.

### ***Response to Arguments***

Applicant's arguments filed 3/16/09 have been fully considered but they are not persuasive.

The provisional ODP rejection is not the only outstanding rejection in the instant application. Therefore the rejection is maintained as per reasons of record. It is noted that the applicants did not argue the rejection on the merits.

Applicant submits that the polymer is always acrylic because n and q can only separately be zero.

Only claim 9 has the language of  $n = 0$  when  $q > 0$  and  $q = 0$  when  $n > 0$ . Claim 7, now claim 32, claims that n and q are between 0 and 95, without the limitation of claim 9. Additionally, claims 8 and 10 – 20 depend on claim 32. Without the proper limitation

added to claim 32, said claim is indefinite when  $n = 0$ . Examiner would also like to point out that when  $n = 0$  the molecule is not acrylic, unless one of R9, R10, R11 or R12 is a carboxylic group. However, carboxylic acid is only one of many choices claimed for said substituents.

Applicant submits that Feraudy's separation can only achieve a differential of 0.03 with one or several parallel separators and purification lines in series.

Feraudy discloses one or several separators, which is also claimed by Applicant, and uses the same materials as claimed by Applicant (the waste material, powder such as clays, salts or sand, and wetting agents, specifically the acrylic polymer as disclosed by Boutin). Neither Feraudy nor Applicant discloses the brand of the density measurement reading device used, of which the precision of the reading depends on. Given that the method of separation and the materials used are the same, one can achieve the same differential by using the same brand of separators and of reading equipment. Additionally, both Feraudy and Applicant disclose the use of clays, salts and sand. One can choose said powder through routine experimentation to arrive at the desired result in density differential. Moreover, Allen discloses that the size of the particles should be 5 – 30 microns, as claimed in the instant application. One can choose the type of particle and its size through routine experimentation to arrive at the desired density differential.

Applicant submits that Allen separates used polymers while Applicant uses materials derived from waste.

Examiner respectfully disagrees. "Used polymers" or "polymers from waste" have the same meaning.

Applicant submits that Allen's magnetite particle size are from 5 – 30 microns, as claimed by the instant application, but the size of other particles such as silicone dioxide is not given; that the differential threshold is not better than those disclosed by Feraudy; that hydrocyclone or cylindrical vortex is used which is turbulent as opposed to the hydraulic separator claimed by Applicant in the instant application.

Allen is used herein to teach that metallic powders, magnetite, ferrosilicate, titanium dioxide, sand, can be used, as claimed by Applicant, and that the size of said powder particles range from 5 – 30 microns. Applicant also claims "not more than 30 microns" and "limited to 5 microns". Feraudy discloses the use of clays, bentonites, soluble compounds, salts, calcium carbonate, talc, silica, alumina etc., as claimed by Applicant. Since Allen and Feraudy disclose the use of clays, salts and sand for the same purpose of density separation, it is obvious to substitute Feraudy's powders with Allen's powders that disclose the size of 5 - 30 microns for said powders . Feraudy discloses that the separator can be hydraulic, cyclone, electrostatic, etc. (column 12, lines 3 – 11) but chose hydraulic separator (column 6, line 36), as claimed by Applicant. Allen discloses only cyclone, but it would have been obvious to combine the references since both disclose cyclone for the same purpose of density separation. Additionally, Allen is used herein to teach the size of the powder particles used in density separation; Feraudy discloses the hydraulic separators claimed by Applicant.

Applicant submits that Boutin does not overcome the deficiencies of Feraudy or Allen.

Feraudy discloses the use of stabilization agents to keep the powder in suspension, as claimed by Applicant. The agent used, however, is SP 30 S from the company Coatex. Boutin is used herein to teach that other stabilization agents, such as the sulfonate of acrylic polymers claimed by Applicant, are used for the same purpose of keeping powders in suspension.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **FRANCES TISCHLER** whose telephone number is

(571)270-5458. The examiner can normally be reached on Monday-Friday 7:30AM - 5:00 PM; off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ Irina S. Zemell/  
Primary Examiner, Art Unit 1796

Frances Tischler  
Examiner  
Art Unit 1796

/FT/